

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the personal interview conducted on July 16, 2003 between the Examiner, his supervisor, and applicant's representative. The application has been carefully reviewed in light of the Office action and the interview, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

The Examiner objected to the drawings for not showing features recited in claims 18, 21, and 24-27, namely the "removable" or "adjustable" nature of the magnet or the coil extension angles. At the interview, this issue was discussed in detail. The Examiner and his supervisor agreed that the request for drawing information was directed at an issue of enablement (discussed under the §112 rejection, below), and the Examiner and supervisor also agreed that there was not likely a practical way to show those features in a drawing. Accordingly, applicant has not amended the drawings.

At the interview, the Examiner objected to references to the claims on pages 1 and 3. The specification has been amended to remove those references, making the objection moot.

Claims 13-35 remain in this application. Claims 1-13 have been previously canceled. New claims 36-39 have been added.

Claims 18, 21, and 24-27 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter not described in the specification in such a way as to enable one skilled in the art to practice the invention. Applicant respectfully traverses this rejection.

The specification discusses coil extension in the second last paragraph on page 5. The specification also discusses making the magnet removable on the last paragraph of page 5, and discusses adjustability of the magnet at the top of page 6. In addition, these features were recited in original claims 7, 9, and 10. Further, one skilled in the art of implantable devices would know the procedures and adaptations

necessary to implement such features. Accordingly, the application is sufficiently enabled to allow one skilled in the art to practice the invention, as claimed. Accordingly, applicant requests that this rejection be withdrawn.

Claims 13, 14, and 19-26 were rejected under 35 U.S.C. §102(b) as being anticipated by Hough (U.S. 4,606,329). For the following reasons, the rejection is respectfully traversed.

Claim 20 has been canceled, making its rejection moot.

At the interview, the limitation of a permanent magnet adapted for being "solidly attached" to a promontory was discussed. It was agreed that, after a cursory review of the prior art by the Examiner, that the references did not suggest such a limitation, and thus the amendment would overcome the prior art. Also discussed was a limitation that a coil be adapted for placing "in the inner ear", which also was not suggested by the Hough reference. Although the interview summary by the Examiner suggests amending claim 13 to have both limitations, applicant's representative has determined that the "solidly attached" limitation, alone, is sufficient to distinguish over the Hough reference, and thus would make claim 13 patentable over Hough.

Accordingly, claim 13 has been amended to recite "at least one permanent magnet adapted for being solidly attached on a promontory in the area of the middle ear". As discussed at the personal interview (discussed above and in the Interview Summary), Hough does not suggest a permanent magnet being "solidly attached" on a promontory. Instead, Hough clearly states that its vibration generating means 50 is "secured between the promontory and the medial surface of the handle of the malleus", which does not suggest any attachment to the promontory. Accordingly, claim 13 is patentable over Hough.

Claims 14-27, which depend, either directly or indirectly, on claim 13, are thus patentable for the same reasons (as well as for the limitations contained therein). Further, claim 22 has been amended to recite that the coil is adapted for placing "in the inner ear" as discussed at the interview. For that reason as well, claim 22 is patentable over Hough.

New claim 36 recites a "permanent magnet adapted for being removeably attached to a promontory" and a coil "for placing in the area of the middle ear for directly transferring sound vibrations to a component of the middle ear." Hough does not suggest it's coil for "directly transferring sound vibrations to a component of the middle ear" and thus new claim 36 is patentable over Hough. New claims 37-39, which depend, directly or indirectly, on claim 36, are patentable for the same reasons (as well as for the limitations contained therein).

New claim 40 recites a permanent magnet "adapted for being mounted on a promontory" and a coil "adapted for placing in the middle ear." As discussed at the interview, Hough does not suggest a coil adapted for placing "in the middle ear", and thus claim 40 is patentable over Hough. New claims 41-44, which depend, directly or indirectly on claim 40, are patentable for the same reasons (as well as for the limitations contained therein).

Claims 13-18, 28, 29 and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perkins (U.S. 6,084,975). For the following reasons, the rejection is respectfully traversed.

Claim 13 recites a magnet "solidly attached on a promontory" and a coil "in the area of a middle ear." Claim 28 recites similar limitations. New claim 36 recites a "permanent magnet adapted for being removeably attached to a promontory" and a coil "for placing in the area of the middle ear for directly transferring sound vibrations to a component of the middle ear." New claim 40 recites a permanent magnet "adapted for being mounted on a promontory" and a coil "adapted for placing in the middle ear." The remaining claims depend, directly or indirectly, on one of the cited claims.

The Office action admits that Perkins does not teach the invention as recited in the claims, above. Instead, the Office action cites Perkins as teaching a coil positioned on a promontory and a permanent magnet on a tympanic membrane. As discussed at the personal interview, placing the permanent magnet on the promontory is functionally different, in that the coil becomes the vibrating device and the magnet at least substantially stationary. Further, the coil can be made smaller and operate at a lower current, whereas the magnet can be made larger, as

discussed in the specification on page 4. Accordingly, there is disclosed significance to the reversal of the coil and the magnet, because it affects the manner in which the device operates, and the devices themselves. Accordingly, there is no "mere reversal" and hence the rejection cannot stand (see MPEP §2144.04(VI)). Further, the "mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims...is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). Here, the prior art has provided no such motivation or reason. Accordingly, the Examiner is requested to withdraw the rejection for this reason.

Further, the Examiner states that a "functional limitation" that the prior art is "inherently capable" of performing does not overcome the prior art. The Examiner states that the magnet and coil of Perkins are "capable" of being placed as recited in the claims. However, adapting a magnet to be attached "on a promontory" or a coil to be placed in the "area of the middle ear" are not a "functional" limitations, but structural limitations, that are not implied by Perkins (see col. 3, lines 22-38), and would not be understood as being interchangeable by one skilled in the art.

Consequently, for this reason as well, applicant requests that the Examiner withdraw these rejections and allow claims 13-18, 28, 29 and 33-44.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

• Appl. No. 09/932,353
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If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33891.

Respectfully submitted,

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